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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,835	04/13/2004	Engel Visscher	2333-45	5532
20575 7590 05/18/2007 MARGER JOHNSON & MCCOLLOM, P.C. 210 SW MORRISON STREET, SUITE 400 PORTLAND, OR 97204			EXAMINER HAGEMAN, MARK	
			ART UNIT 3653	PAPER NUMBER
			MAIL DATE 05/18/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/823,835	<b>Applicant(s)</b> VISSCHER ET AL.	
	<b>Examiner</b> Mark Hageman	<b>Art Unit</b> 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 3-8-2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 11-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 11-19 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

**DETAILED ACTION**

***Election/Restrictions***

1. Newly submitted claims 11-19 are directed to inventions that are independent or distinct from the invention originally claimed for the following reasons: The inventions of claims 11-19 all utilize an air shaft or vacuum assembly. Originally filed claim 1 recited no such structure and posses separate utility as a separation screen using shafts as claimed to separate paper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 11-19 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1 (now claims 1-10), drawn to a material separation screen, classified in class 209, subclass 668.
  - II. Claims 11-15, drawn to a method for separating materials, classified in class 209, subclass 667.
  - III. Claims 16-19, drawn to a vacuum shaft assembly, classified in class 209, subclass 591.

As discussed above invention I has been constructively elected by original presentation for prosecution on the merits and therefore claims 11-19 drawn to inventions II and III have been withdrawn.

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3. Inventions I, II, and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as a separation screen using shafts, as originally claimed (original claim 1), to separate paper. Subcombination III has separate utility such as vacuum shaft assembly in a materially different separation screen or a material conveyance. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

### ***Specification***

The specification is objected to under 37 CFR 1.71 for not being "in full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same." Examiner questions the disclosure of the vacuum shaft system and requests clarification as to how the system works. Paragraphs 25-29 of the specification contain the subject matter in question. Examiner does not understand how the system can function as disclosed. As understood by the examiner the divider (70) is in contact with the vacuum shaft (60) and rotates therewith. If this is true Examiner does not understand how the airflow can be varied by changing the position of the divider. If the divider is stationary and the shaft rotates around it the system seems to work in the disclosed manner. This seems unlikely though as the fins (72) form a tight abutment against the inside walls of the vacuum shaft (60, para 26 lines 5+). Examiner requests clarification as to whether the divider (70) rotates with the shaft and a general description as to the functioning of the air shaft system. Examiner further requests clarification as to how the airflow is introduced into the air shaft. If the divider rotates does the air source rotate with it or is the air source stationary adjacent the rotating air shaft?

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 2, 4, 6, 7, 9, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 1, 2, 6, 7, 9 and 10 recite the limitations involving "the member etc.". Claim 1 introduces multiple elongated members. Any references to the multiples elongate members of claim 1 should use the language elongated member in order to clearly set forth which members are being referred to. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 4 recites the limitation "the vacuum member" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. Claim 4 depends from claim 1 which does not recite a vacuum member. Claim 4 also recites the limitation "the input holes" in line 3. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 10 includes "to form and overlapping stair stepped gap between dual diameter discs" which renders the claim indefinite as it is not understood what is meant by "overlapping stair stepped gap." As best understood examiners believes this to mean the configuration shown in figure 6. If this is the case the claims does not seem to further limit claim 9 from which it depends.

All claims have been treated as best understood.

### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 2, and 6-10 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,960,964 to Austin et al. Austin discloses multiple elongated members (16 and figure 1) aligned along a separation screen frame (12) and configured to rotate in a direction causing materials to move along the separation screen (c4 lines 10+), the members configured with a shape and spacing so that substantially materials move along the screen while non-rigid or semi-rigid pieces of the materials slide down between adjacent members. Examiner contends that, “the members configured with a shape and spacing so that substantially materials move along the screen while non-rigid or semi-rigid pieces of the materials slide down between adjacent members” is functional language in that it does not provide a structural limitation to the claim, see MPEP 2114. Examiner further contends the Austin device is fully capable of functioning in this manner.

-Re claim 2 the members have a round cross-sectional shape with a substantially smooth outside surface (30). Examiner contends that the spacers actually make up the outside surface of the members.

- Re claim 6 including discs (18) located on at least some of the members.

-Re claim 7 the discs have multiple sides that maintain a substantially constant spacing with discs on adjacent members (c4 lines 22+).

-Re claim 8 at least some of the discs are dual diameter discs having a primary disc with a first outside perimeter and a secondary disc with a second outside perimeter smaller than the first outside perimeter (c9 lines 15+).

-Re claim 9 the primary disc on a first member is aligned with the secondary disc on a second adjacent member and the secondary disc on the first member is aligned with the primary disc on the second adjacent member (c9 lines 15+ and figure 15).

-Re claim 10 the dual diameter discs are aligned to form an overlapping stair stepped gap between dual diameter discs on adjacent members (c9 lines 15+ and figure 15).

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austin in view of US 4,789,068 to Gilmore. Austin discloses all the limitations of the

claims except at least one vacuum member that includes input holes, the vacuum member includes output holes, and a divider located inside the vacuum member.

Gilmore discloses at least one vacuum member (22) that includes input holes (34, figure 4 and c2 lines 48+), the vacuum member includes output holes (34, figure 4 and c2 lines 48+), and a divider (24) located inside the vacuum member (figure 4) for the purpose of drawing small material through the screen in order to remove smaller particles from the stream of material (c3 lines 7+). Examiner contends that the language following "configured to" in the claims is functional and does not provide and structural limitation to the claim and therefore is not given patentable weight. Positive recitation of a vacuum source and/or a positive pressure source could provide patentable weight to the discussion the air flow relative to the holes.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Austin to include at least one vacuum member that includes input holes, the vacuum member includes output holes, and a divider located inside the vacuum member, as taught by Gilmore, for the purpose of drawing small material through the screen in order to remove smaller particles from the stream of material.

### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Hageman whose telephone number is (571) 272-3027. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCH



PATRICK MACKEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600